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| 10/088,230      | 03/19/2002  | Kazuo Hiraguchi      | Q69036              | 1692             |

7590 08/28/2003

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Washington, DC 20037-3213

EXAMINER

HAUGLAND, SCOTT J

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3654

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/088,230

Applicant(s)

HIRAGUCHI ET AL

Examiner

Scott Haugland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-16 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 6-14, drawn to magnetic tape cassettes.

Group II, claim(s) 15 and 16, drawn to a method of making guide rollers.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I is directed to the problem of adapting of cassettes of different sizes to use in the same recording and reproducing apparatus. Group II is directed to a method of making guide rollers.

During a telephone conversation with Tracy Johnson on 4/16/03 a provisional election was made without traverse to prosecute the invention of Group I, claims 6-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15 and 16 are withdrawn from

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further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Drawings***

Figures 10-14 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

Claim 14 is objected to because of the following informalities: Claim 14 does not end with a period. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of the claims are not clear since it is not clear if a single cassette or a collection of cassettes is claimed and, if a collection is claimed, how the cassettes of that collection are physically, structurally, or cooperatively related. E.g., would a cassette having the claimed dimensions relative to an existing cassette meet the claims?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by the admitted prior art of page 1, line 7 - page 7, line 19 of the specification and Figs. 10-12.

The admitted prior art discloses magnetic tape cassettes adapted to be operated in a recording and reproducing apparatus that can operate cassettes of different sizes (p. 3, line 15 - p. 4, line 15) comprising (a) magnetic tape, (b) tape reels 70, 80 having upper flanges 71, 81, lower flanges 72, 82, and bosses 73, 83, (c) an upper cassette half 51, (d) a lower cassette half 52, (e) tape running openings 57a, 57b, and (f) guide members 58a, 58b.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art of page 1, line 7 - page 7, line 19 of the specification and Figs. 10-12.

The admitted prior art discloses a magnetic tape cassette (e.g., Fig. 12(a)) adapted to be operated in a recording and reproducing apparatus that can operate cassettes of different sizes (p. 3, line 15 - p. 4, line 15) including L, M, and S cassettes (page 4, lines 4-15) comprising (a) magnetic tape, (b) tape reels 70, 80 having upper flanges 71, 81, lower flanges 72, 82, and bosses 73, 83, (c) an upper cassette half 51, (d) a lower cassette half 52 having ribs 59a, 59b formed at the front end of the lower half, (e) tape running openings 57a, 57b, (f) guide members 58a, 58b, and (g) positioning marks (positioning holes) 90a, 90b.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make plural cassettes identical to a cassette (e.g., the Fig. 12(a) cassette) of the admitted prior art in order to produce cassettes for sale. A set of two such cassettes, which have the

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same horizontal length, meets the claims. The claims do not require that the horizontal length of the cassettes be different (claims 6 and 12 only say "may vary"). Since there is no variation in horizontal length in this instance, the claimed requirement that "when the horizontal length varies ..., distances between positioning marks are the same ..." is satisfied.

With regard to claims 9-11, the language "plurality of sizes of ... cassettes" refers to the sizes of cassettes that the recording and reproducing apparatus can operate. It does not refer to the sizes of the claimed cassettes. The prior art recording and reproducing apparatus is disclosed as being capable of operating cassettes of these sizes.

Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art of page 1, line 7 - page 7, line 19 of the specification and Figs. 10-12.

The admitted prior art discloses magnetic tape cassettes adapted to be operated in a recording and reproducing apparatus that can operate cassettes of different sizes (p. 3, line 15 - p. 4, line 15) including L, M, and S cassettes (page 4, lines 4-15) comprising (a) magnetic tape, (b) tape reels 70, 80 having upper flanges 71, 81, lower flanges 72, 82, and bosses 73, 83, (c) an upper cassette half 51, (d) a lower cassette half 52 having ribs 59a, 59b formed at the front end of the lower half, (e) tape running



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openings 57a, 57b, (f) guide members 58a, 58b, and (g) positioning marks (positioning holes) 90a, 90b. The distance between positioning marks 90a, 90b are the same in cassettes of different sizes (p. 6, lines 16-21). The cassettes have the same vertical length and varying horizontal lengths (p. 3, lines 15-18).

The admitted prior art does not disclose that the difference between the height of radially inner portion of the lower flanges and the height of the ribs is the same for all of the cassettes.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the difference between the height of the radially inner portion of the flanges of the cassettes and the height of the ribs the same for all of the cassettes to provide the same clearance between the tape and ribs and to locate the tape in the same position in the recording and reproducing apparatus no matter what size the cassette is or to allow its use in a different recording and reproducing apparatus. The claims do not require all of the cassettes to be adapted for use in the same or same type of recording and reproducing apparatus. However, they are inherently adapted for that purpose.

Claims 7, 8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art of page 1, line 7 - page 7, line 19

of the specification and Figs. 10-12 as applied to claim 6 above, and further in view of Ota et al (Japanese document No. 5-347079).

The admitted prior art does not disclose that the distance between guide members 58a, 58b varies among the tape cassettes, that inclinations defined by connecting the bosses and guide members are the same in all of the cassettes, or that the widths of tape running openings are the same in the cassettes.

Ota et al teaches making the distance between guide members 5, 5, 27, 27 different on cassettes of different sizes (Figs. 13, 15) adapted to be used in the same recording and reproducing apparatus. The inclinations defined by connecting the bosses and the guide members appear to be similar in cassettes of different sizes (Figs. 13, 15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the distances between guide members in cassettes of different sizes different as taught by Ota et al and to make the inclinations of the tape running paths the same to provide similar tape feeding tension characteristics for the cassettes since Ota et al teaches that the tape need not exit cassettes of different sizes at the same points relative to a tape recording and reproducing apparatus in order for the cassettes to be used in the same tape recording and reproducing apparatus. It would have been obvious to make the widths of the tape

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running openings the same on cassettes of different sizes since the same size of tape is used in all of them and would not require different sizes of access openings.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ogata et al and Anderson et al are cited to further show cassettes of different sizes that are adapted to be used in the same recording and reproducing apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Haugland whose telephone number is (703) 305-6498. The examiner can normally be reached on Monday - Thursday and every second Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on (703) 308-2688. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

*[Handwritten initials]*

sjh

8/20/03

*Kathy Matecki*

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